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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,673	08/06/2001	Anthony Singer	MARKS 1	1540

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EXAMINER
COBURN, CORBETT B

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,673	Applicant(s) SINGER ET AL.	
	Examin r Corbett B. Coburn	Art Unit 3714	

-- The MAILING DATE of this communicati n appears on the cover sh et with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *8,9 and 11-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10 and 19-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Examiner has read Applicant's comments on the Election/Restriction requirement and there is obviously some confusion. Examiner acknowledges that he is responsible for a certain amount of this confusion because the prior office action gives the appearance that the election/restriction requirement was withdrawn. This is not the case. In order to clarify the record, the election/restriction requirement is hereby reissued.

2. Claims 1-7, 10, 25 & 26 are generic to a plurality of disclosed patentably distinct species comprising:

Group I: Claims 8 & 9 drawn to a species of bonus games in which the bonus feature is activated if a predetermined result occurs during play.

Group II: Claims 11 & 16-18 drawn to a species of bonus game activated if a predetermined symbol appears on the screen.

Group III: Claim 12 drawn to a species of bonus game activated on a random basis.

Group IV: Claim 13 drawn to a species of bonus game activated according to a predetermined schedule.

Group V: Claim 14 drawn to a species of bonus game activated as a result of a decision made by a player.

Group VI: Claim 15 drawn to a species of bonus game activated as a result of an action of a player.

Group VII: Claims 19-24 & 27 drawn to a species of bonus game activated if a predetermined symbol appears on the payline.

3. Applicant will note that Examiner has adopted the grouping of the claims suggested by Applicant in Paper #4.

4. In Paper #4 Applicant elected Group VII. This election is acknowledged and accepted and was acted upon in the previous office action (Paper #5).

5. Applicant traversed the election requirement stating that the claims should have been restricted a combination/subcombination. This is not the case because the claims do not meet the requirements of MPEP 806.05(c). The claims are not written as Ab_{br}/B_{sp}. Since the claims to the purported combination/subcombination are presented and assumed to be patentable, the omission of details in the claimed subcombination in the combination claim is evidence that the patentability of the combination does not rely on the details of the specific combination.

6. In this case, we have the generic claims A (Claims 1-7, 10, 25 & 26) that define a game machine and method of operation. Then we have a series of different embodiments disclosed with potentially patentably distinct bonus games. ~~A~~ AB_1 – AB_8. Each of the bonus games $B_1 - B_8$ is different from the other and does not require details of the other games for patentability. For instance, a gaming machine (A) with a bonus game (B_1) that is activated if a predetermined result occurs during play is different from, and perhaps patentably distinct from, a gaming machine (A) with a bonus game (B_8) that is activated if a predetermined symbol appears on the payline.

7. Examiner will search the generic claims (1-7, 10, 25 & 26) and one species. Applicant has elected Group VII, claims 19-24 & 27. These claims will be treated on the merits. All other claims (8, 9 & 11-18) have been withdrawn as non-elected.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-7, 10, 19, 20 & 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatley et al (GB 2,239,547) in view of Piechowiak (US Patent Number 6,012,982) and Itkis (US Patent Number 6,227,969).

Claims 1, 25. Gatley teaches a gaming device in which each slot game has a plurality of reels, a plurality of symbols associated with each reel – i.e., a "fruit machine". (Abstract) Gatley's gaming machine having at least a first slot game and second slot game thereon. (Abstract) The first slot game to operates independently of the second slot game with regard to the activation of the slot reels, the display of the symbols on each reel and the determination of an outcome on each pay line and there is a common pool of credits from which each slot game uses credits to make wagers and to which each slot game accrues awards from any winning occurrences on the slot game. (Page 2)

Gatley does not, specifically teach a plurality of pay lines for each game. Multiple paylines are extremely well known in the art. Piechowiak teaches multiple paylines. (^12-614) Having multiple paylines encourages players to bet more money on each game because the chance of winning increases with the amount bet. This increases the casino's profits. It would have been obvious to one of ordinary skill in the art at the

time of the invention to have each game have multiple paylines in order to encourage players to bet more money on each game, thus increasing the casino's profits.

Gatley fails to teach displaying the multiple games on a single video monitor. Itkis displays multiple games on a single screen. (Fig 4) Having a single video display screen instead of multiple screens would reduce the cost of Gatley's invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Gatley in view of Itkis to use a single video display in order to reduce costs.

Claims 2, 26: Gatley teaches using a separate input means to make a wager on each slot game and using a separate means to activate the start of each slot game. (Control buttons, page 2, line 25) Each game comes with a separate display panel (p 2, 25), which is a separate means to allow a player to view an explanation of the operation, rules and payouts for each game. Gatley indicates that a common credit register may be provided (p 2, 32-34), this implies that separate registers to allow the player view the wager made, the credits accrued and other information pertinent to the operation of each game may also be provided. Gatley teaches using a common control means to allow the player to receive a payout of any amount of accrued credits. (p 2, 34-36)

Claim 3: It is clearly possible for each of Gatley's games to be the same game in every aspect, including having the same set of rules, symbols, pay lines, wagers, music, artwork and random number generator.

Claim 4: Gatley states that each module may provide a different game. (p 3, 24-25) Thus each game may be a different game in one or more aspects, including having a

different set of rules, symbols, pay lines, wagers, music, artwork or random number generator.

Claim 5: Clearly each of the slot games on Gatley's gaming machine may be selected by a manufacturer of the gaming machine.

Claim 6: Since Gatley discloses removing and replacing games (p3, 19-25), each of the slot games on the gaming machine may be selected by a gaming establishment who is acquiring the gaming machine.

Claim 7: Gatley discloses displaying both available games for the player to choose from. This is equivalent to providing that each of the slot games on the gaming machine is selected by the player of the gaming machine from a menu of available games provided on the gaming machine.

Claim 10: Piechowiak teaches that each slot game includes randomly selecting and displaying one or more pay lines of at least three symbols (Fig 6). Piechowiak teaches the player making a first wager on a first pay line, a second wager on a second pay line and additional wagers on any subsequent pay lines by drawing from the common pool. If the resulting symbols of any pay line comprise a predetermined winning combination, to the common pool is credited a predetermined amount based on the amount of the corresponding wager. The player takes money from a common pool (the player's bankroll) and the common pool (the bankroll) is credited by any winnings – i.e., the player puts the money in his pocket. Furthermore, Gatley teaches a common credit register (p2, 31-36) from which bets are taken and to which winnings are paid.

Claims 19, 27: Gatley teaches the invention substantially as claimed, but does not teach a bonus game. Piechowiak teaches providing each slot game with a bonus screen feature which is activated if at least one predetermined symbol appears on an active pay line on the slot game screen display. (Col 1, 59-62) Piechowiak teaches that with a bonus game, "the players enjoy a heightened interest and enthusiasm in the gaming machine" that "translates into higher revenue for gaming machine proprietors". (Col 1, 38-43) It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided each slot game with a bonus screen feature which is activated if at least one predetermined symbol appears on an active pay line on the slot game screen display in order to allow the players to "enjoy a heightened interest and enthusiasm in the gaming machine" that "translates into higher revenue for gaming machine proprietors".

Claim 20: Piechowiak teaches that there are one or more predetermined features (e.g., bonus screen features). (Col 3, 54-55) Piechowiak also teaches that the bonus screen feature is selected randomly from this plurality of possible bonus screens. (Col 4, 63-65)

10. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatley, Piechowiak and Itkis as applied to claim 19 above, and further in view of Thomas et al. (US Patent Number 6,190,255).

Claim 21: Gatley, Itkis, and Piechowiak teach the invention substantially as claimed, but does not teach a "pick-em" game. Thomas teaches such a game. Thomas teaches displaying at least two objects on a bonus screen (Fig 8). The player selects a bonus screen object which reveals an award to the player (the number symbols in Fig 9) until the player selects a bonus screen object that causes the bonus screen feature to end (the

"Party Pooper" symbols in Fig 9) and accruing to the common pool of credits the total accumulated amount of the award achieved by the player during the play of the bonus screen feature. (Col 10, 25- Col 11, 13) "Pick-em" games are popular because players feel they have more control over the outcome. It would have been obvious to one of ordinary skill in the art at the time of the invention to have implemented the bonus screen feature as a "Pick-em" game (as described in Thomas and immediately above) in order take advantage of the popularity of such games by allowing the players to feel they have more control over the outcome.

Claim 22: Piechowiak teaches the bonus screen award includes a special feature award in which the player receives an award based on the total amount wagered by the player. (Col 9, 22-24)

Claim 23: Thomas discloses randomly selecting from a group of possible multiplier numbers. (Col 5, 35-62) Thomas teaches that "bonus resources" are randomly chosen outcomes of the game and that they may be bonus multipliers.

Claim 24: Thomas teaches that the special feature award is an amount calculated to result in an average value that can be utilized to control the overall average payout of the gaming machine. (Fig 7)

Response to Arguments

11. Applicant's arguments with respect to claims 1-7, 10 & 19-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dabrowski et al (US Patent Number 5,356140) and Yoseloff ((US Patent Number 6,277,969) teach multiple games on one screen.

13. Since there has been confusion regarding the election/restriction requirement, this action is NON-FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

cbc

JESSICA HARRISON
PRIMARY EXAMINER